

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY PACKRALL and ANDREW JAY BURKETTE

Appeal No. 2000-0859
Application No. 08/777,668

ON BRIEF

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9 to 21. Claims 1 to 8 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. No claim has been canceled.

We REVERSE.

BACKGROUND

The appellants' invention relates to a podium convertible from a shipping case (claims 9 to 15), a shipping case convertible to a podium (claims 16 to 18) and a method of converting a shipping case to a podium (claims 19 to 21). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Callahan 1996	5,562,229	Oct. 8, (filed May 24, 1995)
Rueter 1997	5,680,944	Oct. 28, (filed Mar. 4, 1996)

In addition, the examiner also relied upon Official Notice that it was known in the art to use a storage container for storing a convertible pop-up display (Official Notice).

Claim 9 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Rueter.¹

Claims 9 to 14, 16, 17 and 19 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rueter in view of Callahan.

Claims 15 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rueter in view of Callahan as applied to claims 9 and 16 above, and further in view of Official Notice.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 15, mailed February 26, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief

¹ While the examiner has cited 35 U.S.C. § 102(b) as the basis for this rejection, it is clear that the correct basis for this rejection would be 35 U.S.C. § 102(e).

(Paper No. 14, filed December 31, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claim 9 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 9 reads as follows:

A podium convertible from a shipping case, the podium comprising a container having a bottom wall, a vertical wall, an upper platform defining a work surface, a decorative panel for extending about the container, and means for detachably fastening said decorative panel to said container to be flush with said platform.

Rueter's invention relates to a thermos bottle liner system and more particularly pertains to maintaining a thermos bottle cool while providing the user with a towel that can be wetted to cool the body. As shown in Figures 1-4, the thermos bottle liner system generally designated by the reference numeral 10 includes (1) a thermal bottle 12 having a cylindrical side wall 14, a closed bottom wall 16 and an opening; (2) a lid 20 formed with an opening 22 with a removable cover 24 for pouring the contents of the bottle therefrom; (3) an inverted "U" shaped handle 26 having free ends 28 coupled to an upper extent of the bottle for transportation purposes; and (4) a cover 32 which is positionable in a cylindrical configuration around the side wall 14 of the bottle. The cover 32 includes pile type fasteners 54 and 56 releaseably coupled with respect to each

other so that the cover 32 can be wrapped around the side wall of the thermal bottle.

We agree with the appellants' argument (brief, pp. 4-5) that claim 9 is not anticipated by Rueter. In that regard, it is our view that the claimed term "podium" is not readable on Rueter's thermos bottle liner system.² Furthermore, the claimed "means for detachably fastening said decorative panel to said container to be flush with said platform" is not met by Rueter for the following reasons. In order to meet a "means-plus-function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578,

² The term "podium" must be given it the broadest reasonable meaning as it would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). When that is done, it is clear that Rueter's thermos bottle liner system does not include a "podium."

27 USPQ2d 1836, 1840 (Fed. Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989). In this case, Rueter does not perform the identical function recited in the means limitation since his cover 32 (i.e., the decorative panel) is not detachably fastened to be **flush** with the lid 20 (i.e., the platform). Additionally, we fail to discern any structure in Rueter that would be an equivalent structure to the structure disclosed in the appellants' specification for performing the function (i.e., recess 48 and continuous strip of hook-type fastener material 50).

Since all the limitations of claim 9 are disclosed in Rueter for the reasons set forth above, the decision of the examiner to reject claim 9 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejection of claims 9 to 21 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

We agree with the appellants' argument (brief, pp. 6-9) that claims 9 to 21 are not obvious under 35 U.S.C. § 103 based upon the teachings of the applied prior art. In that regard, it is our opinion that the applied prior art does not suggest or teach "means for detachably fastening said decorative panel to said container to be flush with said platform" as recited in independent claim 9; "means defining an elongate recess in said vertical wall which is adjacent and extends along the periphery of said platform, and means in said recess means for detachably fastening a decorative panel

to said container" as recited in independent claim 16; or "detachably attaching the decorative panel to the shipping case to be flush with an upper platform thereof" as recited in independent claim 19.

In our view, the only suggestion for modifying the applied prior art to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 9 to 21 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 9 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 9 to 21 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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